

REMARKS

The Official Action of July 11, 2008 and the art cited therein have been carefully considered. The remarks herein are considered to be responsive thereto.

In the official Action of May 20, 2008 the Examiner issued a restriction requirement to one of two inventions: Group I: claims 1-31 drawn to compounds of formula I, II, III or IV; and Group II: claims 32-44 drawn to method of using the compound of formula I, II, III or IV. Applicants responded to the restriction requirement by electing Group I and selecting the species of example 67 to be examined.

In the official Action of July 11, 2008 the Examiner deemed Applicants response to the Restriction Requirement unpersuasive because claim 1 claims four compound formulas which have different cores. The Examiner then withdrew claims 4-19, 29 along with 32-44. However, the Examiner's July 11 restriction requirement was never based on the existence of four compound formulas in claim 1. Applicant's arguments only addressed the restriction as it related to compound claims (Group I) versus method claims (Group II). Thus, Applicant's did not have an opportunity to put forth arguments regarding whether the compounds of claim 1 were patentably distinct.

Applicants now take the opportunity to argue that the compounds of formulas I, and II, have the common technical feature of a pyrazole substituted with a biphenyl. Likewise, the compounds of formulas III and IV have the common technical feature of a pyrazole substituted with phenyl pyridinyl. A search of the compounds of formula I would necessarily encompass the compounds of formula II. Equally, a search of the compounds of formula III would render compounds of formula IV. This is particularly true if the Examiner searches by compound name. Thus, there would be no undue burden to search the compounds of formula II with the compounds formula I and the compounds of formula IV with the compounds of formula III.

Claims 21, 22, 26 and 28 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. Claims 21, 22, 26, 28 and 29 have been amended to include compound numbers next to each row of compounds. No new matter has been added. The fact that the compounds appear in table format does not render the compounds indefinite. One of

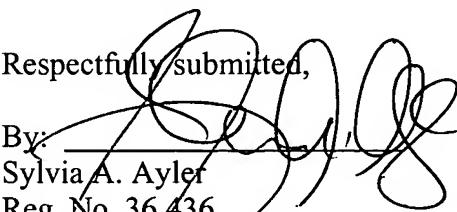
Case 21374YP

ordinary skill in the art would have no problem understanding which compound is being claimed because each R value is clearly defined for each compound in all the rows.

Claim 1 is rejected under 35 USC 102(b) as being anticipated by Finar, et al., J. Chem Soc, Section B: Physical Organic, Vol. 2, pages 211-214, 1968, and Finar, J Chem. Soc., Section B: Physical Organic, Vol. 7, pages 725-732, 1968. The Examiner states that Finar discloses biphenyl substituted pyrazole compounds. Claim 1 has been amended to recite "with the proviso that R¹, R³ and R⁶ are not hydrogen at the same time" to remove any overlap with Finar.

Claims 1-3, 20-28 and 30-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of co-pending application no 10/551,709. Applicant's will address this issue when it is the only one that remains as USSN 10/551,709 is still a pending application.

Respectfully submitted,

By: 
Sylvia A. Ayler
Reg. No. 36,436
Attorney for Applicant(s)
MERCK & CO., INC.
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-4909

Date: July 31, 2008